

Remarks

Applicant has reviewed the Office Action dated as mailed August 1, 2005 and the documents cited therewith. After the above amendments have been made, the present application contains claims 1-14 and 16-27. Claims 1-8, 10, 11, 13, 17 and 20 have been amended.

Claim Rejections under 35 U.S.C. §101

Claims 1-19 were rejected under 35 U.S.C. §101 because the claims were asserted as being directed to a non-statutory subject matter, specifically, directed towards a data structure. Applicant respectfully submits that claims 1-19 are method claims or process type claims which are statutorily sanctioned under 35 U.S.C. §101 as statutory subject matter. Additionally, claim 1 as been amended to recite:

“determining in a device whether a digit or a wildcard as been entered in the device by a user for each entry until a first digit is entered by the user.”

Additionally, claim 13 has been amended to recite “receiving in a device a first entry by a user.” Accordingly, Applicant respectfully submits that claim 1 and claims 2-12 which depend directly or indirectly from claim 1 and independent claim 13 and claims 14 and 16-19 which depend directly or indirectly from independent claim 13 are directed to statutory subject matter, and reconsideration and withdrawal of the 35 U.S.C. §101 rejection of these claims is respectfully solicited.

Claim Rejections Under 35 U.S.C. §112

Claims 1-12 were rejected under 35 U.S.C. §112 as being indefinite in that in claim 1, line 3, the recitation of “receiving a first digit” is vague and indefinite. Applicant respectfully submits that claim 1 has been amended to more particularly point out and distinctly claim the subject matter of

the present invention. Therefore, reconsideration and withdrawal of the 35 U.S.C. §112 rejection of claims 1-12 is respectfully requested.

Claim Rejections Under 35 U.S.C. §102

Claims 1-8, 11, 13-14, and 16-27 were rejected under 35 U.S.C. §102(e) as being anticipated by Simon et al. (U.S. Patent No. 6,442,270; herein after Simon). These rejections are respectfully traversed.

Turning initially to the rejection of independent claim 1 under 35 U.S.C. §102(e) as being anticipated by Simon, Applicant respectfully submits that the rejection under 35 U.S.C. §102(e) does not follow M.P.E.P. § 2131 which states:

“TO ANTICIPATE A CLAIM, THE REFERENCE MUST TEACH EVERY ELEMENT OF THE CLAIM

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).”

The Office Action on page 4 admits that Simon does not disclose wildcards. Accordingly, Applicant respectfully submits that the rejection under 35 U.S.C. §102(e) is improper. Additionally, the Office Action went on to state that “[I]t would have been obvious to one having ordinary skill in the art at the time the invention was made to provide wherein the searching by number displaces any other combination of number that is available in the storage as being a wildcard search in order to provide precise inefficient searching”. Applicant respectfully submits that the present invention as recited in claim 1 would not be obvious and respectfully requests that a prior art reference teaching the use wildcards and the other features of the present invention as recited in the claims be cited so that the Applicant may appropriately address any such prior art and the propriety of any rejection in view of such prior art.

Additionally, claim 1 has been amended to recite:

“determining in a device whether a digit or a wildcard has been entered in the device by a user for each entry until a first digit is entered by the user”

and claim 1 has been further amended to recite:

“determining in the device whether another digit or another wildcard has been entered in the device by the user for each additional entry until another digit is entered by the user in response to the user not selecting any number in a previous match list; and searching the previous match list to form a new match list including any numbers matching a current sequence of digits and wildcards entered by the user in response a last entry by the user being a digit.”

Applicant respectfully submits that there is no teaching or suggestion of these features as recited in amended claim 1 and there is no document of record in the current application that would render these features of the present invention obvious in view of Simon or any other document of record. For all of these reasons, Applicant respectfully submits that claim 1 is patentably distinguishable over Simon, and reconsideration and withdrawal of the 35 U.S.C. §102(e) rejection of claim 1 is respectfully solicited. Support for the amendment to claim 1 may be found in Figure 3 and paragraphs 0021 and 0023 of the specification.

Turning now to the rejection of claims 2-8 and 11 under 35 U.S.C. §102(e) as being anticipated by Simon, these claims contain additional features which further patentably distinguish over Simon. For example, claim 3 recites “ending the search in response to one of no stored numbers matching the sequence of digits and wildcards” and “a predetermined number of digits or digits and wildcards being entered.” As discussed with respect to claim 1, Simon does not teach or suggest a sequence of digits and wildcards and as further discussed with respect to claim 1, Applicant respectfully submits that the use of wildcards as provided by the present invention as recited in the claims would not be obvious to one having ordinary skill in the art.

Additionally, claim 4 recites:

“performing an intelligent pre-match before displaying each match list, wherein performing the intelligent pre-match comprises entering only one variation of the same number once in each match list.”

Applicant respectfully submits that Simon does not teach or suggest an intelligent pre-match as provided by the present invention as recited in claim 4. Furthermore, claim 8 recites “displaying only one stored number of a group of stored numbers in each match list that are variations of the same phone number.”

Claims 2-8 and 11 also depend either directly or indirectly from independent claim 1, and by virtue of that dependency, contain all of the features of independent claim 1. For all of the reasons

discussed above Applicant respectfully submits that claims 2-8 and 11 are also patentably distinguishable over Simon, and reconsideration and withdrawal of the 35 U.S.C. §102(e) rejection of claims 2-8 and 11 is respectfully solicited.

With respect to the rejection of independent claim 13 under 35 U.S.C. §102(e) as being anticipated by Simon, the Office Action on page 7 admitted that Simon does not teach or suggest using wildcards. However, the Office Action went on to assert that it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide wherein the searching by number displaces any other combination of number that is available in the storage as being a wildcard search in order to provide precise and efficient searching. Based on this assertion in the Office Action, Applicant respectfully submits that the 35 U.S.C. §102(e) rejection of independent claim 13 does not follow M.P.E.P. §2131. Additionally, Applicant respectfully submits that the use of wildcards as provided by the present invention as recited in claim 13 is not obvious to one having ordinary skill in the art and requests that a prior art reference supporting such an assertion be provided so that Applicant can properly respond. Accordingly, Applicant respectfully submits that independent claim 13 is patentably distinguishable over Simon, and reconsideration and withdrawal of the Section 102(e) rejection of claim 13 is respectfully requested.

Regarding the rejection of claims 14 and 16-19, these claims recite additional features which further patentably distinguish over Simon. Additionally, these claims depend either directly or indirectly from independent claim 13. Because of this dependency, these claims contain all of the features of independent claim 13. Accordingly, claims 14 and 16-19 are also submitted to be patentably distinct over Simon, and reconsideration and withdrawal of the 35 U.S.C. §102(e) rejection of these claims is respectfully requested.

Turning now to the rejection of independent claim 20 under 35 U.S.C. §102(e) as being anticipated by Simon, claim 20 recites similar features to claims 1 and 13 namely, "searching any stored numbers in response to receiving at least one digit or a sequence of digits and wildcards to form a match list". Additionally, the Office Action on page 8 admits that Simon does not teach or suggest wildcards. Accordingly, Applicant respectfully submits that the rejection of claim 20 under 35 U.S.C. §102(e) is improper for the same reasons discussed with respect to claims 1 and 13. Applicant respectfully contends that the use of wildcards as provided by the present invention as recited in claim 20 is not obvious and that a prior art reference teaching using wildcards and the

other features of the present invention as recited in claim 20 be provided so that Applicant may appropriately respond. Accordingly, reconsideration and withdrawal of the 35 U.S.C. §102(e) rejection of independent claim 20 is respectfully solicited.

With respect to the rejection of claims 21-24, these claims recite additional features which further patentably distinguish over Simon. Additionally, these claims depend either directly or indirectly from claim 20 and by virtue of that dependency, contain all of the features of independent claim 20. Therefore, Applicant respectfully submits that claims 21-24 are also patentably distinguishable over Simon, and reconsideration and withdrawal of the 35 U.S.C. §102(e) rejection of these claims is respectfully requested.

Regarding the rejection of independent claim 25 under 35 U.S.C. §102(e) as being anticipated by Simon, claim 25 recites similar features to independent claims 1, 13 and 20. For the same reasons as discussed with respect to these claims, claim 25 is submitted to be patentably distinguishable over Simon. Accordingly, reconsideration and withdrawal of the Section 102 rejection of claim 25 is respectfully requested.

With respect to the rejection of claims 26 and 27 under 35 U.S.C. §102(e) as being anticipated by Simon, these claims, recite additional features which further patentably distinguish over Simon. For example, claim 27 recites “performing an intelligent pre-match before displaying any stored numbers matching the at least one digit or the sequence of digits and wildcards.” As previously discussed, Simon does not teach or suggest an intelligent pre-match as provided by the present invention as recited in the claims.

Additionally, claims 26 and 27 depend either directly or indirectly from independent claim 25. Because of that dependency claims 26 and 27 contain all of the features of claim 25. Accordingly, Applicant respectfully submits that these claims are, therefore, also patentably distinguishable over Simon. Reconsideration and withdrawal of the 35 U.S.C. §102(e) rejection of claim 26 and 27 is respectfully solicited.

Claim Rejections Under 35 U.S.C. §103

Clam 9-10 and 12 were rejected under 35 U.S.C. §103(a) as being unpatentable over Simon in view of Amro et al. (U.S. Patent No. 6,542,591; herein after Amro).

With respect to claims 9 and 10, Amro was cited for teaching that the searching is accomplished at least in part by searching a call list a missed call list and a phonebook. Column 8, lines 1-28 and figures 5a and 5b were cited on page 8 the Office Action for this teaching. In reviewing Column 8, lines 1-28 and figures 5a and 5b of Amro, Amro appears to be teaching use of caller identification to respond to missed telephone calls and does not teach or suggest searching a call list, a missed call list and a phonebook as asserted in the Office Action. Additionally, claims 9 and 10 depend either directly or indirectly from independent claim 1. Because of this dependency, claims 9 and 10 contain all of the features of independent claim 1. For all of these reasons, Applicant respectfully submits that claims 9 and 10 are patentably distinguishable over Simon and Amro, whether considered individually or combined, and reconsideration and withdrawal of the 35 U.S.C. §103 rejection of claims 9 and 10 is respectfully solicited.

Turning now to the rejection of claim 12 under 35 U.S.C. §103(a) as being unpatentable over Simon in view of Amro, Amro was cited for teaching selecting a search by number feature from a menu by voice activation. While Amro may teach voice recognition in the portions of Amro cited in the Office Action, Applicant respectfully submits that Amro does not teach or suggest selecting a search by number feature from a menu by voice activation. Additionally, claim 12 depends directly from claim 1 and by virtue of that dependency contains all of the features of claim 1. Applicant respectfully submits that Amro adds nothing to the teachings of Simon so as to render claim 1 unpatentable. Therefore, claim 12 is submitted to be patentably distinguishable over Simon and Amro, whether considered individually or combined, and reconsideration and withdrawal of the 35 U.S.C. §103 rejection of claim 12 is respectfully requested.

Conclusion

For the foregoing reasons, the Applicant respectfully submits that all of the claims in the present application are in condition for allowance. Reconsideration and withdrawal of the rejections and allowance of the claims at the earliest possible date are respectfully solicited.

If the Examiner has any questions about the present Amendment or anticipates finally rejecting any claim of the present application, a telephone interview is requested.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 13-4365.

Respectfully submitted,

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